

Remarks

The Applicants note with appreciation the withdrawal of the obviousness-type double-patenting rejection of Claims 1 and 3-10. The Applicants also acknowledge the continued rejection of Claims 1 and 3-10 as anticipated by Tsunekawa.

The Applicants have amended Claim 1 to incorporate the subject matter of Claim 7 and have accordingly canceled Claim 7.

The Applicants note with appreciation the Examiner's helpful and detailed comments concerning the applicability of Tsunekawa to the solicited claims. There are differences that compel allowance of the claims over Tsunekawa. The solicited claims recite that the breaking strength in the machine direction is 80 to 150% to obtain films with high insulation breakdown voltage and long charge life. This is described in the Applicants' specification at page 13, lines 10-18. Also, the stretch ratio is set at three times or more and less than four times both in the machine direction and the transverse direction to provide films with an elongation at break set within the 80 to 150% range. Support may be found in the Applicants' specification at page 24, lines 18-25, wherein it is disclosed that the stretch ratio is preferably set at three to four times and in the case of a stretch ratio four times or more, excessive orientation should be avoided. This is further disclosed by comparing Examples 1-10 on the one hand and Comparative Examples 3 and 4 on the other hand.

In sharp contrast, Tsunekawa provides stretch ratios in his Examples, with the exception of Example 5, that are less than three times or four times or more. Thus, the elongation of break in the machine direction is outside of the range of 80 to 150%.

This invention also recites in the solicited claims that the content of the polyimide (B) is in the range of 5 to 30% by weight to obtain films with electrical properties such as insulation volume resistance and insulation breakdown voltage at high ambient temperature and charging life at high

ambient temperature. Support for this aspect of the invention may be found in the Applicants' specification on page 14 at lines 22 through page 15, line 3. This is also disclosed by comparing Examples 1-10 on the one hand and Comparative Examples 1 and 2 on the other hand. Comparative Example 1 reveals that when the content of the polyimide is less than 5% by weight, the film is low in insulation breakdown voltage and poor in charge life (see Table 1, Table 2). Comparative Example 2 reveals that, when the content of the polyimide is more than 30% by weight, the film is low in elongation of break and hence low in insulation breakdown voltage and poor in charge life (see page 37, line 19 to 23).

Referring back to Example 5 of Tsunekawa, it has a content of 40% by weight of the polyimide. Therefore, the content of the polyimide (B) must inherently or necessarily be outside of the claimed range of 5 to 30% by weight. Accordingly, the Applicants have demonstrated that the characteristics and the structure of the invention as recited in the solicited claims is entirely different from Tsunekawa. The Applicants respectfully request withdrawal of the rejection based upon Tsunekawa.

Furthermore, the Applicants note with appreciation the Examiner's comments that "it is to be pointed out in the Tsunekawa et al reference that the film is taught to have a surface roughness (see column 14, lines 29-35) and it is inherently in the range of 10 nm to 140 nm." The Applicants fully agree that Tsunekawa contemplates that the films taught therein have a surface roughness as noted in column 14. A means for determining the surface roughness is specifically provided at the location noted in the Official Action.

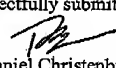
However, the Applicants respectfully submit that the fact that Tsunekawa accounts for the fact that the Tsunekawa films have a surface roughness in no way can be interpreted that a surface roughness is inherently in the claimed range of 10 nm to 140 nm. Tsunekawa is completely silent

as to what the surface roughness (Ra) of the film therein really are. Those of ordinary skill in the art are left to speculate as to what the surface roughnesses of the films of Tsunekawa might actually be. Careful scrutiny of the entire disclosure reveals that there is not one word of the actual surface roughness range disclosed by Tsunekawa.

It must be remembered in utilizing inherency of a characteristic in forming a rejection that the inherent characteristic must necessarily flow from the disclosure. In this case, there is nothing that is provided by Tsunekawa that would lead one of ordinary skill in the art to believe that the claimed surface roughness of 10 nm to 140 nm would inherently be present. Again, the fact that Tsunekawa acknowledges that the films therein have a surface roughness and a means to calculate the surface roughness in no way would lead one of ordinary skill in the art to necessarily conclude that the surface roughness would be within the claimed range. In fact, it could be in any range. Therefore, the Applicants respectfully submit that there is no disclosure in Tsunekawa that justifies a rejection based on inherency. On that ground alone, the Applicants respectfully submit that Claims 1, 3-6 and 8-10 are allowable over Tsunekawa.

In light of the foregoing, the Applicants respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,

  
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